

REMARKS

The Examiner has rejected claims 1-3 and 14-16 under 35 U.S.C. 102(e) as being anticipated by Thomas et al. (US Pat. 6,173,272) and claims 4-13 under 35 U.S.C. 103(a) as being unpatentable over Thomas as applied to claim 1 and further in view of Remington et al. (US Pat. 6,070,150). Reconsideration of these grounds of rejection is respectfully requested.

The present invention allows the biller to grant access to the bill presentment service provider's website by providing the information required by the service to identify the client that is paying the bill. The biller is only required to provide information along with its presented bill which is already within its database and, for that matter, already within most presented bills (e.g., client's biller account number and the amount outstanding. The biller places this information within an HTML form which is placed on the presented bill. The HTML form includes a bill payment icon which the client can simply click to authorize payment. This automatically initiates the forwarding of the HTML form to the bill payment server. This feature is specifically claimed in claim 1 as the "means to communicate said bill payment instructions to said bill processing server when said means for initiating bill payment instructions is selected". Such a system is not taught or suggested by Thomas et al.

With respect to the rejection of claims 1-3 and 14-16 under 35 U.S.C. 102(e) as being anticipated by Thomas et al., the Examiner has compared claim 1 to the prior art disclosure in Figure 1 of Thomas et al. The system of Figure 1 of Thomas et al. bears little resemblance to the invention of claim 1. The bill forwarded from Biller B to Consumer C is a conventional paper bill (column 2, line 13). Biller B is typically not a willing participant in the system (column 2, line 1). Accordingly, and contrary to the Examiner's characterization of Thomas et al., Biller B does not include in the bill information "input means for selecting said means for initiating bill payment instructions" which when selected by Consumer C "communicate[s] said bill payment instructions to said processing server" as claimed in claim 1. In contrast, upon receipt of the bill, Consumer C in the prior art system disclosed in Thomas et al. must independently contact the service bureau and enter payment instructions. This is done after Consumer C has prepared an "enrollment package" including the "biller B's name, address, telephone number and the C-B account number" (column 2, lines 17-27). In this system, the bill payment instructions must be generated by Consumer C and are not part of the billing information generated by Biller B. Such a system is similar to the prior art system described with reference to US Pat. 5,383,113 at page 2 of the present application in which the service bureau maintains a merchant list and associated user account information from which it coordinates payment.

Accordingly, it is submitted that claims 1-3 and 14-16 are not anticipated by Thomas et al. and withdrawal of the rejection under 35 U.S.C. 102(e) is respectfully requested.

With respect to the rejection of claims 4 - 13 under 35 U.S.C. 103(a) as being unpatentable over Thomas as applied to claim 1 and further in view of Remington et al. (US Pat. 6,070,150), the Examiner has acknowledged that Thomas et al. fails to disclose that bill information is a bill image and that the bill payment instructions is an HTML form and identified Remington et al. as an example of an electronic bill presentment and payment system wherein the bill image and payment instructions are transmitted to a customer over the Internet. While it is clear that Remington et al. places a bill image and a payment icon in an HTML form, the functionality of such a form is entirely different than that of the rejected claims. In particular, "Pay" button 228 on Figure 7 to which the Examiner refers is used to "activate a payment remittance graphical UI screen" (column 11, lines 60-63) as shown in Figure 10. This form is then transmitted back to the biller (column 13, lines 56-59) and not to an independent bill processing server as claimed in the present invention.

Remington does contemplate that the HTML form can be used in a system with an independent bill presentment and payment remittance service provider as shown in Figures 11 and 12. However, in such a case, the service provider "handles billing responsibilities for the biller" and "acts as a centralized bill warehouse and delivery mechanism" (column 16, lines 19-24). This requires that all bills to be paid be uploaded from the billers' websites and centrally stored in the bill payment server. In contrast, in the present invention, the bills to be presented reside on numerous biller servers (14A, B & C) each being populated by individual billers. This arrangement allows the client to access the appropriate server, view a particular bill and generate the payment instructions that are forwarded to the bill processing server. Because, in the Remington et al. embodiments which employ a bill presentment service, the bills are located on one server computer, the biller must contract out this service, something that is typically very expensive to set up and involves ongoing fees. In addition, the solution taught by Remington et al. involves the passing of a business critical function to a third party bill presentment provider and also makes confidential client information available to the third party bill presentment provider. Furthermore, there are increased operational costs associated with the database maintenance and updating required to pass payment information to and from the third party bill presentment server. Finally, the biller loses marketing control to the client as the client does not go to the biller's website as the first point of contact.

It is submitted that there is simply no disclosure in either cited reference of the use of an electronic bill format which is sent from the biller to the customer which contains the

“means to communicate [the] bill payment instructions” (e.g. the website address of the bill payment server as part of an HTML form) to automatically link to the payment server upon payment authorization. This functionality is claimed in claim 1 and by dependency in all other claims. Accordingly, it is submitted that claims 4-13 are patentable over Thomas in view of Remington et al. and withdrawal of the rejection under 35 U.S.C. 103(a) is respectfully requested.

Claims 10 and 23 have been amended to change dependency, thereby providing antecedent basis for the term “said billing image” contained in each claim.

With respect to the drawing amendment, the applicant has noted that Figure 1 contains a drawing error. As described at page 10, lines 14 to 16, client computer 18 can access the home page of each biller server 14. Figure 1 shows only one such connection between client computer 18 and one biller server. The corrected Figure 1 corresponds with the description and properly shows each biller server 14 being connected to client computer 18. Moreover, Figure 1 also showed a connection between biller servers 14 and bill processing server 12. While the biller must establish a relationship with the bill processing organization, the payment process does not involve such a direct connection. This is clear from the description of the system which makes no mention of any direct connection between biller servers 14 and bill processing server 12 and describes the payment connection only between the client and the bill processing server. Accordingly, the depiction of such a direct connection in Figure 1 may give rise to confusion. Therefore, in order that the drawing more accurately reflect the description, Figure 1 has been amended to remove the lines between biller servers 14 and bill processing server 12.


Minor corrections to clerical errors on pages 7 and 10 have also been made.

In view of the foregoing, applicants believe that all of the claims are now in condition for allowance and respectfully request the Examiner to pass the subject application to issue. If for any reason the Examiner believes any of the claims are not in condition for allowance, he is encouraged to phone the undersigned at (650) 849-7777 so that any remaining issues may be resolved.

Aside for the Petition for Extension of Time fee, no additional fee is believed due for filing this response. However, if a fee is due, please charge such fee to Pennie & Edmonds LLP's Deposit Account No. 16-1150.

Respectfully submitted,

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APPENDIX A

Changes to the Specification

The paragraph at page 7, line 27 is revised as follows:

One aspect of the system of the present invention preferably operates using the Web. With a communications modem and a browser a client using client computer 18 can permanently or on a dial-up basis access the Internet through an Internet Service [provide] Provider (ISP) such as America Online, CompuServe, and Prodigy. ISPs operate servers which are connected to the Internet. A "browser" is a computer program that resides on a computer enabling a user to view web documents. The web browser handles the function of locating and targeting information on the Internet and displaying information provided by a web server. Examples of web browsers include Microsoft Internet Explorer™ and Netscape Navigator™. The foundation on which the Web functions is Hypertext using Hypertext Markup Language (HTML). Hypertext is the organization of information units into connected associations that a user can choose to make. An instance of such an association is called a link or hypertext link. URLs (uniform resource locators) are the unique addresses of documents on the Web. HTML is a standardized language of computer code, embedded in "source" documents behind all Web documents, containing the textual content, images, links to other documents (and possibly other applications such as sound or motion), and formatting instructions for display on a user's screen. Browsers are programmed to interpret HTML for display. HTML often imbeds within it other programming languages and applications such as SGML, XML, Javascript, CGI-script or the like. SHTML refers to secure HTML which denotes messages passing between computers which have been encrypted as will be explained later.

The paragraph at page 10, line 14 is revised as follows:

A general overview of the present invention can now be provided. In one aspect of the present invention, biller servers 14 each have an associated home page which a client computer 18 can access through their local Internet Service Provider. At the home page of the biller, the client will enter their account number and be immediately provided with information relating to the current billing period. The information is presented in the form of a bill image with account data covering the last invoice period, along with an indication of

the amount outstanding against the account. An example of such a bill image is depicted at Figure 2. The bill image is actually part of a larger HTML form which contains information which cannot be viewed by the client. The larger HTML form is presented in Figure 3 where it can be seen that the actual invoice information (the position of which is shown generally at 20) presented to the client comprises only one portion of the form. The hidden information in the form includes a unique biller identification number (VENDORID), a biller invoice number (VENDORSEQ), and a customer account number (PAYEEACCOUNT). As shown in Figure 2, the client is presented with a payment amount at input field 22 which the client can accept or modify. To affect payment, the payment icon 24 is selected which causes the client computer 18 to send the HTML form to the bill processing server 12. Referring to Figure [2] 3, it can be seen that the HTML form directs that the transmission be sent to the web site <http://secure.telpay.ca/cgi-bin/telpay>. The bill processing server then sends a payment confirmation screen as depicted in Figure 4 to the client. The client is then prompted to enter an authorization code in field 26, to confirm the client's identity. The client then confirms payment by selecting the "Yes" icon 28. Upon receipt of the client's confirmation message, the bill processing server 12 debits the client's account by contacting a selected one of the financial institution servers 16 and credits the biller's account by contacting a selected one of the financial institution servers 16. Alternately, bill processing [sever] server 12 transmits transaction information to clearing house 11 which facilitates the debiting and crediting activities. In either case, when the debit and credit activity is complete, both client computer 18 and biller servers 14 are notified by bill processing server 12 that the payment has been processed.

APPENDIX B

Changes to the Claims

The rewritten claims were revised as follows:

10. (Amended) The system of claim [1] 4 wherein said billing image further includes marketing banners and marketing hypertext links to information stored on said one or more biller servers.

23. (Amended) The method of claim [14] 17 wherein said billing image further includes marketing banners and marketing hypertext links to information stored on said one or more biller servers.